



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	CLASS	ATTORNEY DOCKET NO.
09/409,680	09/30/99	NAKANISHI	M	

IM62/0621
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CHEA.T	EXAMINER
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ART UNIT 1756	PAPER NUMBER
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DATE MAILED: 06/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/409,680

Applicant(s)

Nakaishi et al

Examiner

Thorl Chea

Group Art Unit

1752



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This first office action is responsive to the filing of this instant application.
2. Claims 1-30 are pending in this instant application.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7-12, 17-21, 24-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Czekai et al ('331).

The '331 discloses a submicron particles of material such as pigment useful in paints or a compound useful in imaging element which comprises milling the agent in the presence of milling media having mean particle size of less than about 100 microns (abstract). Any suitable compounds useful in the imaging element and the use thereof in the photographic element is described from column 11 to column 35. Czekai may not produce the submicron particles of compound useful in the imaging element having steps presented in the claimed invention. Czeck discloses solid particle having size and composition similar to that of the claimed invention. Thus,

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the claimed invention is either anticipated by or would have been found obvious over Czeck. “(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the claim is unpatentable even though the prior art product was made by different process.” *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

6. Claims 7-12, 17-21, 24-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Czekai et al ('705).

The '705 discloses particle compound useful in imaging elements which are milled using a milling media comprising polymeric resin. The use of polymeric milling media permits the production of particles having an average particle size less than 1 microns (abstract). The compound useful in imaging element in solid particle forms and the use thereof in a photographic material are described in columns 9-31. Czeck discloses solid particle having size and composition similar to that of the claimed invention. Thus, the claimed invention is either anticipated by or would have been found obvious over Czeck. “(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art, the

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claim is unpatentable even though the prior art product was made by different process.” *In re Thorpe* 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985).

7. Claims 13-16, 22-23, 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the ‘333 patent and ‘705 patent as applied to claims 7-12, 17-21, 24-18 above, and further in view of Lobo et al (Lobo).

Lobo discloses the use of an ionic polymer within the scope of the claimed invention to create a small particle photographic dispersion of PUMs without increasing the level of surface active material or hydrophilic colloid, without increasing the homogenizing temperature and without the use of auxiliary solvent. Note to the problem to be solved in column 4, lines 10-15, and the polymer in columns 11-12. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the polymer taught in Lobo in the process for preparing a solid fine particle taught in the ‘333 patent or ‘705 patent for same reason taught in Lobo, and thereby provide a material as claimed.

8. Claims 12, 21, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the ‘333 patent and ‘705 patent as applied to claims 7-12, 17-21, 24-18 above, and further in view of Scaringe et al (Scaringe).

The compounds claimed in claim 12, 21, 28 have known as photographic filter dyes and taught in Scaringe in column 7, lines 47-68. It would have obvious to form a solid fine solid particle of a known photographic useful group including the filter dyes taught in Scaringe, and thereby provide a material as claimed.

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9. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Czekai et al ('705) in combination with Canepa et al (Canepa), Bishop et al (Bishop) or Inkyo et al (Inkyo).

The '705 discloses particle compound useful in imaging elements which are milled using a milling media comprising polymeric resin. The use of polymeric milling media permits the production of particles having an average particle size less than 1 microns (abstract). The polymeric resin using as milling media include polyuethane, polytetrafluoroethylene or high density polyethylene (column 3, lines 25-53). Milling can take place in any suitable milling mill includes a ball mills , a media ball mill or bead mill (column 4, lines 35-41). The compound useful in imaging element in solid particle forms and the use thereof in a photographic material are described in columns 9-31. Canepa, Bishop and Inkyo each discloses an agitating ball mill apparatus similar to that of the apparatus using in the claimed process. This apparatus is used in the process for grinding solid particle or mixing photographic dispersion. Note to Bishop in column 1, lines 5-10, and the apparatus shown in Bishop in sheets 1-4; Canepa, Sheets 1-6; and Inkyo, sheets 1-9. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use a known mills known in the art including those disclosed in Bishop, Canepa, or Inkyo in the process for forming a solid particles of compound useful in imaging element taught in the '705 to provide a process as claimed. The diverse steps present in the claims are inherent to the apparatus taught in Bishop, Canepa or Inkyo because of its similarity to the apparatus used in the present invention.

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10. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. Chea whose telephone number is (703) 308-3498. The examiner can normally be reached on M-F from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Janet Baxter, can be reached on (703) 308-2303. The fax phone number for this Group is (703) 305-5408; (703)305-3599; (703) 305-3601; or (703)305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

txch
June 8, 2000



Thorl Chea
Primary Examiner
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